

REMARKS

Claims 1 – 9, 11 – 18, and 20 – 25 are currently pending and claims 20 – 23 have been withdrawn. The Examiner rejected claims 1 – 9, 11 – 18, and 24 – 25 as obvious under §103 in view of a variety of references. Applicants submit the following arguments in response to the rejections.

§103 Rejection in view of Jackson, Futami, and Henriksson

The Examiner rejected claims 1 – 4, 8, and 9 under §103 as obvious over Jackson (U.S. 6,516,466) in view of Futami (GB 2,308,775) and further in view of Henriksson (U.S. 5,845,219). Independent claim 1 claims a cellular telephone that plays pre-recorded audio and video. Further, claim 1 requires *inter alia* a screening memory for storing a list of preferred callers and a microprocessor that stops playback of stored audio and video signals responsive to an incoming call from a preferred caller so that the user may receive the incoming call.

The Examiner asserts that Jackson teaches a portable device that includes a transceiver, signal processing circuit, and entertainment module. Further the Examiner asserts that Futami teaches a cellular telephone that stops the playback of pre-recorded audio signals when an incoming call is received. Finally, the Examiner asserts that Henriksson teaches a cellular telephone that notifies a user of an incoming call only if the caller matches one of the callers in a list of preferred callers stored in the phone. Based on these facts, the Examiner asserts “it would have been obvious to one of ordinary skill in the art to incorporate the feature of storing priority or preferred numbers for controlling incoming calls in Jackson’s device as modified by Futami’s portable telephone set in order to ensure the reception of important calls regardless of a user’s location as taught by Henriksson, while avoiding interrupting music playback unnecessarily.” However, contrary to the Examiner’s assertions, there is no motivation to combine Henriksson with either Jackson or Futami. Instead, the Examiner uses impermissible hindsight to combine the references to reconstruct the claimed invention.

Both Jackson and Futami describe portable music playback devices. However, neither Jackson nor Futami teach interrupting music playback responsive to receiving an incoming call from a preferred caller. While Henriksson teaches alerting a user of an incoming call from a preferred caller (Abstract, column 1, line 38 through column 2, line 8), there is nothing in Henriksson that teaches interrupting any kind of current phone operation, much less interrupting music or video playback, responsive to receiving an incoming call from a preferred caller. Further, there is nothing in Henriksson that suggests the desirability of using the preferred caller method to interrupt active phone operations, such as music playback. Further still, there is nothing in either Jackson or Futami that suggests the desirability of interrupting music playback based on specific information associated with an incoming call.

However, simply because one or more individual elements of a claimed invention are arguably known does not mean that it is obvious to combine these elements. In fact, it is important to understand that the mere fact that prior art can be modified to form a claimed invention does not make that modification obvious absent a showing that the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989); in re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984).

Regarding the present application, the Examiner appears to extract individual elements from different disjointed inventions in an attempt to reconstruct the claimed invention using impermissible hindsight, rather than showing that the prior art suggests the desirability of such modifications. This approach is legally insufficient. An obviousness rejection must rest on sound factual basis, and these facts must be arrived at without reconstructing the invention from the prior art through hindsight. The PTO may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply the deficiencies in its factual basis. In re Warner, 379 F.2d 1011, 1017 (CCPA 1967), cert denied. 389 U.S. 1057 (1968).

Because the prior art does not suggest the desirability of the modification, the Examiner has not made a prima facie case of obviousness against independent claim 1. As such, the rejection must be withdrawn. Applicants respectfully request reconsideration of the rejection of independent claim 1 and dependent claims 2 – 4, 8, and 9.

§103 Rejection in view of Goodman, Futami, and Chin

The Examiner also rejected claims 1, 11 – 13, and 18 under §103 as obvious over Goodman (U.S. 5,594,779) in view of Futami and further in view of Chin (U.S. 5,661,788). However, as with the §103 rejection discussed above, there is no motivation to combine Goodman with Futami and Chin.

Goodman also teaches a mobile phone capable of playing audio signals to a user. As discussed above, Futami teaches a cellular telephone that stops the playback of pre-recorded audio signals when an incoming call is received. Further, Chin teaches a selective answering system based on a list of previously identified numbers. In particular, as discussed in the response filed for the previous office action, when a user in Chin receives a call from a caller on the predetermined list, a pre-recorded message begins to play to the caller. As such, it appears that the Examiner relies on Chin solely for the preferred caller list feature. However, in applying Chin to the teachings of Goodman and Futami, the Examiner completely ignores the context of Chin's teachings and instead applies Chin in a manner that was not anticipated or intended by Chin. In other words, instead of relying on the actual teachings of Chin, the Examiner instead extracted specific elements from different inventions in an attempt to reconstruct the claimed invention of the present application. As discussed above, such reconstruction can only be based on hindsight, which is not allowed under §103.

In addition, it is important to note that Chin says nothing about interrupting any kind of current phone operation, much less interrupting music or video playback, responsive to receiving an incoming call from a preferred caller. Further, there is nothing in Chin that

suggests that the desirability of only interrupting phone operations, such as music playback, based on a preferred caller list. Further still, there is nothing in either Goodman or Futami that suggests the desirability of interrupting music playback based on specific information associated with an incoming call. As such, for substantially the same reasons provided above, there is no motivation for the skilled user to combine the references.

For at least these reasons, Applicants respectfully request the Examiner reconsider the rejection of independent claims 1 and 11, and dependent claims 12 – 13 and 18.

§103 Rejection in view of Goodman and Kimura

The Examiner rejected independent claims 24 and 25 under §103 as obvious in view of Goodman and Kimura (U.S. 5,522,049). Claims 24 and 25 claim a mobile communication device that plays audio signals stored in memory. In particular, claim 24 requires “a removable battery pack attachable to said transceiver unit, said memory being located in said battery pack,” while claim 25 requires “a detachable adapter for attaching to said transceiver unit, said memory being located in said adaptor.”

As discussed above, Goodman teaches a mobile phone capable of playing audio signals to a user. However, as conceded by the Examiner Goodman does not teach a removable battery pack or detachable adaptor that includes the memory used to store the audio signals. For this teaching the Examiner relies on Kimura. However, contrary to the Examiner's assertions, not only is there no motivation to combine the references, the combination does not teach the invention of either claim 24 or 25.

Kimura teaches an integrated circuit (IC) card for use in a computer system. The IC card includes memory and a battery, where the sole function of the battery is to sustain the memory. As taught by Kimura and understood by those skilled in the art, these IC cards function as portable memory devices. There is nothing in Kimura that relates these IC cards to mobile communication devices. Further, there is no clear understanding of how the IC cards

taught by Kimura would even apply to the mobile phone of Goodman. As such, it is unclear how or why the skilled user would ever look to Kimura to supplement the invention taught by Goodman. As such, the Examiner has not satisfied the motivation requirements of §103.

Further, even if there is motivation to combine Kimura with Goodman, the combination does not teach the claimed invention. In interpreting the teachings of Kimura and the claimed invention, it appears that the Examiner broadly interpreted the term "battery pack" to include any electronic device that includes a battery. As such, it appears that the Examiner has equated an IC card that includes a battery with the battery pack of the claimed invention. However, this interpretation goes beyond any reasonable definition of a battery pack. As understood by those skilled in the art, a battery pack for a mobile communication device is a self-contained power system specifically designed to provide power to the mobile communication device when attached to the mobile communication device. The term battery pack does not extend to memory back-up batteries, etc. Further, the skilled user would not define a simple IC card having a battery as a battery pack. As a result, contrary to the Examiner's assertions, Kimura does not teach a battery pack, much less a battery pack that includes memory for storing audio and/or video files. Because Kimura does not teach a battery pack that includes memory, as required by claim 24, Kimura does not solve the defects of Goodman. For at least this reason, neither Goodman nor Kimura, alone or in combination, teach the invention of claim 24.

Further, there is nothing in Goodman or Kimura that teaches a detachable adaptor that includes memory. In fact, the Examiner does not claim that they do. Instead, the Examiner focuses on the limitations of claim 24 (battery pack), while without providing any support for the rejection against claim 25 (detachable adaptor). For at least these reasons, claim 25 is also patentably distinct over the cited art. Applicants respectfully request reconsideration.

Rejections of Dependent claims under §103

Applicants note that because independent claims 1 and 11 are allowable, based on the arguments presented above, dependent claims 2 – 9 and 12 – 19 are necessarily allowable. In addition, Applicants submit that at least claims 6, 7, 14, 17, and 18 are also independently allowable.

The Examiner rejected claims 6 and 7 under §103 as obvious over Jackson in view of Futami and further in view of Kimura. Claim 6 depends from claim 1 and requires a removable battery pack that includes the memory of claim 1. Claim 7 depends from claim 1 and requires a detachable adaptor that includes the memory of claim 1. As with the rejections of claims 24 and 25, the Examiner asserts that Kimura teaches the removable battery pack or the detachable adaptor of claims 6 and 7. However, as discussed above, Kimura in fact does not teach this. Therefore, claims 6 and 7 are patentably distinct from the cited art. Applicants respectfully request reconsideration.

Regarding claim 14, the Examiner asserts that the combination of Goodman with Futami and Chin teach the limitations of the claim. Claim 14 claims that the memory of claim 1 comprises a permanent memory that is removable from the cellular telephone for storing and playing audio and video signals. In presenting the rejection, the Examiner “takes Official Notice that it is well known in the art to use removable permanent memory in a cellular telephone for storing data.”

First, Applicants request that if it is well known to use removable permanent memory in a cellular telephone, the Examiner must produce at least one reference that supports this claim. Absent that proof, Applicants submit the Examiner has not sufficiently supported the rejection to satisfy the requirements of §103. Further, Applicants remind the Examiner that the present application was filed 18 February 1998, and that the invention was conceived no later than 20 May 1997. As such, the Examiner must offer proof that removable permanent memory was

known at least before 20 May 1997. Without such proof, the rejection must be withdrawn. For at least these reasons, Applicants request the Examiner reconsider the rejection.

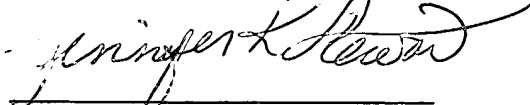
The Examiner also rejected claim 17 under §103 in view of Goodman, Futami, and Chin. As with claim 14, the Examiner took "Official Notice that it is well known in the art to couple a headset to a cellular telephone for playing audio signals so that a user does not have to hold the telephone to his ear in order to hear the signals." With all due respect, the Examiner's point is irrelevant to the limitations of claim 17. Claim 17 requires that the erasable and programmable memory be coupled to a headset port in the cellular telephone. Whether or not it is known to couple a headset to a cellular telephone has no bearing on whether or not it is known to couple memory to a headset port. As such, the Examiner's basis for rejection is insufficient. Further, even if the Examiner maintains that it is known to couple memory to a headset port, Applicants respectfully request that the Examiner provide documented proof. Without such proof, as discussed above, the Examiner has not established a *prima facie* case of obviousness.

#### Conclusion

In light of the above remarks, Applicants submit that claims 1 – 9, 11 – 18, and 24 – 25 are non-obvious in view of the cited art. As such, Applicants respectfully request the Examiner reconsider the rejections and allow the claims. While Applicants believe this response addresses the Examiner's rejections, Applicants request that the Examiner call the undersigned should any issues remain.

Respectfully submitted,

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